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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/073,216

02/13/2002

Tarja Pirttimaa

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03/07/2006

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EXAMINER

PARTHASARATHY, PRAMILA

ART UNIT

PAPER NUMBER

2136

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/073,216

Applicant(s)

PIRTTIMAA ET AL.

Examiner

Pramila Parthasarathy

Art Unit

2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)     | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

1. This action is in response to the communication filed on 1/23/2006. Preliminary amendments to the claims were filed on 2/13/2002 (Please refer to claim objections).

Claims 1 – 35 are currently pending.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Instant application Claims 1 – 35 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 14 of U.S. Patent No. 6,788,676. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant case, all elements of claims 1 – 35 correspond to the claims of 1 – 14 of the patent claims, except in the instant claims, the element, “comparing said first and second source information and dropping message if comparing first source and second source information do not indicate the same location” is referred in the patent claims as “the IMS (IP multimedia subsystem) is able to route subsequent SIP signaling (message) through the IMS proxy (P). It would have been obvious to one having ordinary skill in the art to recognize that providing packet filtering by comparing the first and second source information is equivalent to having an IMS proxy server routing the messages that are registered with the proxy through P-CSCF) filtering.

3. Claims 1 – 35 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 32 of copending Application No. 10/202,563. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant case, all elements of claims 1 – 35 correspond to the claims of 1 – 32 of the copending application claims, except in the instant claims, “comparing said first and second source information and dropping message if comparing first source and second source information do not indicate the same location”, is referred in the copending application claims, as “providing information

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from a wireless network to a mobile terminal, said information being related to availability of an Internet Protocol (IP) Multi-Media (IM) Subsystem (IMS)” where the information is descriptive of a pCSFS address through which the IMS is available”. It would have been obvious to one having ordinary skill in the art to recognize that “comparing said first and second source information and dropping message if comparing first source and second source information do not indicate the same location” is equivalent to IP packet filtering (the information is descriptive of a pCSFS address through which the IMS is available).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Objections***

4. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered and missing claims should either be cancelled or to be renumbered.

5. A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n).

6. A preliminary amendment to the Claims filed on 2/13/2002 is missing Claim numbers 2, 7 and 9 – 11. Claims 22 – 28 are either dependent on Claim 2 or Claim 11. Applicant is advised to either cancel the claims or amend the claims for a series of singular dependent claims (for example, Claims 22 – 27 which are dependent on Claim 2) and designate each Claim with proper designation.

Examiner would like to point out that dependent Claims 2, 7, 9 – 11, 12 and 22 – 28 are not considered in examining and furthermore they are rejected at least by virtue of their dependency on the independent Claims 1 and 13 (see below for the reasons for rejection over prior art).

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1 – 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Ejzak (U.S. Patent Number 6,996,087).

8. Regarding Claim 1, Ejzak teaches a) receiving a message from a terminal device, connected to said packet data network (Summary and Column 3 line 52 – Column 4 line 9);

b) deriving a first source information from said message; c) deriving a second source information (Summary and Column 3 line 52 – Column 4 line 9);

d) comparing said first and second source information; and e) initiating a protection processing based on the result of said comparing step (Summary and Column 3 line 52 – Column 4 line 9);

9. Regarding Claim 13, Ejzak teaches a) receiving means receiving a message from a terminal device, connected to said packet data network (Summary and Column 3 line 52 – Column 4 line 9);

b) deriving means deriving a first source information from said message, and for deriving a second source information (Summary and Column 3 line 52 – Column 4 line 9);

c) comparing means comparing said first and second source information; and d) protecting means initiating a protection processing based on the result of said comparing step (Summary and Column 3 line 52 – Column 4 line 9).

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**10.** Claims 3 and 14 are rejected as applied above in rejecting Claims 1 and 13.

Furthermore, Ejzak teaches wherein said second source information is a source address information derived from a packet data unit used for conveying said message, or from a security association set up between said terminal device and said packet data network (Summary and Column 3 line 52 – Column 4 line 9 and 26 – 65).

**11.** Claims 4, 16 and 30 are rejected as applied above in rejecting Claims 1, 13 and 29. Furthermore, Ejzak teaches wherein said protection processing comprises a processing for dropping said message if said comparing step leads to the result that said first source information and said second source information do not indicate the same location (Summary and Column 4 lines 26 – 65).

**12.** Claims 5, 17 and 31 are rejected as applied above in rejecting Claims 1, 13 and 30. Furthermore, Ejzak teaches wherein said protection processing comprises a processing for dropping said message if said comparing step leads to the result that said first source information and said second source information do not match (Summary and Column 4 lines 26 – 65).

**13.** Claim 6 is rejected as applied above in rejecting Claim 1. Furthermore, Ejzak teaches wherein said first source information is an IP address (Summary and Column 3 line 52 – Column 4 line 9).



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**14.** Claims 8 and 19 are rejected as applied above in rejecting Claims 1 and 13.

Furthermore, Ejzak teaches wherein said second source information is at least a part of an IP source address of an IP datagram (Summary and Column 3 line 52 – Column 4 line 9).

**15.** Claims 15 and 29 are rejected as applied above in rejecting Claims 13 and 14.

Furthermore, Ejzak teaches wherein said deriving means is arranged for deriving said first source information from a header portion of said message (Summary and Column 4 lines 26 – 65).

**16.** Claims 18 and 32 are rejected as applied above in rejecting Claims 13 and 31.

Furthermore, Ejzak teaches wherein said deriving means are arranged for reading said second source information from a database provided at said network element (Summary and Column 4 lines 26 – 65).

**17.** Claims 19 and 33 are rejected as applied above in rejecting Claims 13 and 32.

Furthermore, Ejzak teaches wherein said deriving means are arranged for deriving said second source information by extracting an IP source address from an IP datagram (Summary and Column 3 line 52 – Column 4 line 9).

**18.** Claims 20 and 34 are rejected as applied above in rejecting Claims 13 and 33.

Furthermore, Ejzak teaches wherein said network element is a proxy server (Summary and Column 10 lines 14 – 35).

**20.** Claims 21 and 35 are rejected as applied above in rejecting Claims 13 and 34.

Furthermore, Ejzak teaches wherein said proxy server is a P-CSCF of an IP Mobility Subsystem (Summary and Column 10 lines 14 – 46).

**21.** Claims 2, 7, 9 – 11, 12 and 22 – 28 are rejected at least by virtue of their dependency on the independent Claims 1 and 13.

### ***Conclusion***

**22.** Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.


**23.** The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO Form 892.

Applicant is urged to consider the references. However, the references should be evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. If applicants are aware of any better prior art than those are cited, they are required to bring the prior art to the attention of the examiner.

**24.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pramila Parthasarathy whose telephone number is 571-272-3866. The examiner can normally be reached on 8:00a.m. To 5:00p.m.. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-232-3795. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR only. For more information about the PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pramila Parthasarathy  
February 26, 2006.

  
**AYAZ SHEIKH**  
**SUPERVISORY PATENT EXAMINER**  
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